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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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WASHINGTON DC 20001-5303

In re Application of :  
John B. Classen :  
Serial No.: 08/591,651 : PETITION DECISION  
Filed: February 12, 1996 :  
Attorney Docket No.: CLASSEN=1A :

This is a decision on the renewed petition under 37 CFR 1.181 and the request to hold the reply to the Notice of Non-Compliant Appeal Brief in abeyance, both filed March 5, 2003. The petition under 37 CFR 1.183 to waive the Rules, also filed March 5, 2003, to require the examiner to enter and give full consideration to a declaration filed under 37 CFR 1.132 will be forwarded to the Office of Petitions following mailing of this petition decision.

#### BACKGROUND

The extensive file history is set forth in the previous petition decision and is not repeated herein. Subsequent to the petition decision mailed February 6, 2003, the examiner mailed a Notice of Non-Compliant Appeal Brief to applicant stating that the Brief does not state the correct status of all claims, pointing out the deficiencies and also commenting that an affidavit and exhibits submitted after Appeal were referenced in the Brief even though they had been denied entry. Such was also held to be improper. This renewed petition and request followed and is accompanied by a petition under 37 CFR 1.183.

#### DISCUSSION

Applicant requests reconsideration of the previous petition decision on the basis that it is inconsistent with judicial authority. Applicant then references two court decisions in which post filing date publications or evidence were considered in rendering a decision. It is conceded that post filing date evidence can be utilized to prove specific claims or concepts. The issue at hand is not why the reference was submitted but when it was submitted. In Amgen, for example, the evidence was timely presented during a court proceeding. Amgen is not controlling here because the evidence in this application was not timely presented.

A brief summary of the file history illustrates this point. The rejection of claims under 35 U.S.C. 112, first paragraph was made final on 5 November 2001. The references arrived eleven months

later on 18 October 2002. An extensive after-final prosecution shows that various amendments and interviews took place before these references were provided, including:

Amendment I, filed 2/21/02  
Interview Summary, mailed 3/5/02  
Advisory action, mailed 6/4/02  
Notice of appeal filed 5/6/02  
Amendment J, filed 5/6/02  
Amendment K, filed 5/6/02  
Interview summary, mailed 7/19/02  
Advisory action, mailed 8/20/02  
Advisory action, mailed 9/10/02  
Amendment L, filed 10/18/02

The references cited on the declaration have the following publication dates: 1986; 4/98 and 3/02. Clearly the '86 and '98 references are not newly discovered and could have been submitted anytime after the rejection was initially made. The 3/02 reference was published post-finality; however, applicants did not submit this to the Office for another six months, during which time, numerous correspondence was sent to and from the USPTO concerning this application. If this reference was relevant to the rejection when it was published, why did it take so long to reach the USPTO? Applicants have failed to provide good and sufficient reason why these references were not submitted earlier.

Applicant's second argument is that enablement is ultimately a utility issue and it should not matter how or when the evidence supporting enablement arises. However, as set forth above, the issue herein is not whether the references would have overcome the enablement or utility rejection, but whether the references were timely submitted.

Applicant's third argument is directed to the Office use of later published references to support the rejections of record. However, the examiner provided secondary references having both pre- and post-filing dates of publication in response to applicant's arguments challenging the examiner's arguments in a rejection. No inconsistency is seen in using such references to support a rejection in contrast to not accepting reference evidence in an untimely filed declaration.

Applicant's last argument that the examiner is usurping the Board's function is not correct. The Board of Appeals and Patent Interferences is a reviewing body and primarily reviews the respective positions of an applicant and an examiner relative to patentability of a claim. Such review is based on all evidence and arguments timely presented. The Board does not determine whether an affidavit has been timely presented or not. This is an examiner function and the examiner has properly exercised the right of refusal to consider evidence not presented prior to Appeal.

With respect to the request to hold the requirement to submit a corrected Appeal Brief, such requirement cannot be held in abeyance. The examiner issued a Notice of Non-Compliance on February 11, 2003, setting a time period for reply of 30 days, which time period could be extended under 37 CFR 1.136(a). Absent rescinding the Notice, the reply cannot be delayed. It

is noted that deficiencies in claim status exist which would appear to be easily corrected; also that a correct copy of the appealed claims is not present. Lastly the examiner commented on the unentered affidavit and arguments relating thereto. Such does not make the Brief defective (as stated by the examiner). In preparing an Examiner's Answer the examiner would merely note the presence of such arguments and that they were not considered with the reason why. Thus a corrected Brief including such arguments, but correcting all other errors, would be considered proper.

#### DECISION

Applicant's renewed petition under 37 CFR 1.181 is **DENIED**.

The Request to hold the Notification of Non-Compliant Brief is also **DENIED**, however, the initial period for reply thereto is changed to **THREE MONTHS** from the mail date thereof.

**The petition under 37 CFR 1.183 will be forwarded to the Office of Petitions for consideration.**

Should there be any questions with respect to this decision, please contact Julie Burke, by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-7553 or by facsimile transmission at (703) 305-7230.

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